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REMARKS

Claims 1-2, 8, 10, 27 and 30-33 are currently pending in the subject application and are presently under consideration. Pursuant to an interview initiated by the Examiner, applicants' representative agreed to withdraw the appeal in consideration for allowance of the application after amending the independent claims to recite the limitations of original claims 3 and 4. However, the Examiner has not allowed the claims as previously discussed. As argued in the Appeal Brief, the unamended claims are allowable over the cited prior art. However, in order to expedite allowance, the claims have been further amended. Moreover, claims 3-4 and similar claims 11-12 have been reinstated as new claims 30-33. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-2, 8, 10 and 27 Under 35 U.S.C §112, second paragraph

Claims 1-2, 8, 10 and 27 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Withdrawal of this rejection is respectfully requested for at least the following reasons. One of skill in the art can readily determine the scope of the claims and as such, the claims satisfy the definiteness requirement of 35 U.S.C. §112, second paragraph. The Examiner has made no showing that one of skill in the art would have any difficulty determining the scope of the claims.

Section 112, second paragraph, of the Patent Act states:

[[t]]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

“[T]he test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification.” (*Miles Labs, Inc. v. Shandon*, 997 F.2d 870, 875 (Fed. Cir. 1993) citing to *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). Moreover, “[i]f the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.” (*Miles Labs.*, 997 F.2d at 875 citing to *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367,

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1385 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); *see also Union Pacific Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001); *North American Vaccine, Inc. v. American Cyanamid Co.*, F.3d 1571, 1579 (Fed. Cir. 1993))

The Examiner contends that the claims are indefinite because the Examiner does not understand "how the claimed XML data document component and the data set component being mapped to each other [i.e., what is the mapping mechanism, who did the mapping and how?]." (Office Action dated Oct. 20, 2005 at p. 3). As such, the Examiner is questioning how to make and use the claimed subject matter and merely has repeated the same reasons that formed the basis of the previously appealed lack of enablement rejection. If the Examiner believes that the application does not provided a sufficient teaching of how to make and use the claimed subject matter, a rejection should be brought under 35 U.S.C. §112, first paragraph for lack of enablement. However, as explained in the Appeal Brief, the claims are adequately enabled. (*See Amended Appeal Brief at pp. 4-8*).

To sustain a rejection under §112, second paragraph requires a showing that one of skill in the art would not be able to determine the *scope* of the claims. The Examiner has not pointed to any defect that would prevent one of skill in the art from determining the scope of the claims. Indeed, the scope of the claims is clear and unambiguous. Accordingly, applicants' representative respectfully requests that this rejection be withdrawn.

II. Rejection of Claims 1-2, 8, 10 and 27 Under 35 U.S.C. §103(a)

Claims 1-2, 8, 10 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vandersluis (US Patent No. 6,356,920) in view of Kanai (US Publication No. 2005/0149572). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Vandersluis nor Kanai, either alone or in combination, teach or suggest all of the claim limitations and the Examiner has not established a *prima facie* case of obviousness.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a *whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); *see also e.g., In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere*

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Co., 383 U.S. 1, 17-18 (1966). (See *In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (See *Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must “not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of “common sense” to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). If the PTO relies on multiple prior art references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (See *In re Dembiczak*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); see also *In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of coming forward with evidence or argument shift to the applicant. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

Vandersluis teaches a Hierarchical Data Server (HDS) and Document Definition Authoring System that provide for constructing and editing a Document Definition File (DDF). (See Vandersluis at col. 5, lines 45-51). The DDF contains *hierarchically* related elements. (See Vandersluis at col. 5, lines 48-51 and col. 7, lines 14-21). When a client requests a DDF from the HDS, the HDS processes all of the elements in the DDF and returns a Data File to the client. (See Vandersluis at col. 5, lines 53-55; col. 7, 3-10; and col. 8, lines 43-52). A DDF is created using the Document Definition Authoring System. (See Vandersluis at col. 10, line 30 through col. 11, line 40 and Figs. 4(a)-(b)). Vandersluis teaches that both the DDF and the Data File returned to the client *are hierarchical XML documents*. (See Vandersluis at col. 11, lines 40-55).

Kanai discloses generating and registering meta-data to facilitate retrieval of data. (See e.g., Kanai at Abstract and paras. 0024 and 0028). Meta-data is defined as a “property or attribute” and can include “creation date and location, a creator, an access control information,

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an update log, a data source (information indicating where this data comes from), a channel, an EPG (electronic program guide), a thumb nail in the case of image data, an icon to be displayed by GUI, a position to be displayed on a display, an application that created that data, an application for browsing that data, a MIME type of data, a size of data, and keywords to be used in the retrieval." (Kanai at paras. 0010-11). In the case of XML documents having meta-data (Fig. 10), the system utilizes an XML meta-data correspondence table (Fig. 11) to determine what meta-data to extract from the XML document (Fig. 12). (See e.g., Kanai at paras. 0072-81).

All of the subject claims recite the limitation that *changes* made to information represented in one form (*i.e.*, hierarchical or relational form) are *synchronized* with the information represented in the other form or similar limitations. Neither Vandersluis nor Kanai, either alone or in combination, teach or suggest this novel feature of the subject claims.

Furthermore, the Examiner contends that it would be obvious to modify the system of Vandersluis according to the teachings of Kanai "because by doing so, as suggested the combined system will be upgraded for systematically registering meta-data (or a schema) with respect to various types of individual data so as to facilitate the sophisticated retrieval or application program construction by using the meta-data (or a schema) [e.g., Kanai: Page 2, paragraph 0024]." (Office Action at p. 5). Kanai at paragraph 0024 reads:

[i]t is therefore an object of the present invention to provide a scheme for systematically registering meta-data with respect to various types of individual data so as to enable sophisticated retrieval or application program construction assistance utilizing the meta-data in the data server device.

However, this section of Kanai merely states the advantage of the system of Kanai but does not provide any motivation, teaching or suggestion to combine the features of the system of Kanai with any other system as is required to establish a *prima facie* case of obviousness. For at least the foregoing reasons, applicants' representative respectfully requests that the rejection be withdrawn.

III. New Claims 30-33

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New claims 30-33 are similar to original claims 3, 4, 11 and 12, which were canceled because the limitations were added to their corresponding base claims after a discussion with the Examiner indicated that this would place the claims in condition for allowance. Claims 30-33 depend from claims 1 and 10, which are allowable for at least the reasons stated *supra*. Accordingly, applicants' representative respectfully requests that these claims be allowed.

IV. Other Art of Record

The Examiner contends that the reference referred to as "X-Schema" found at <http://mailman.ic.ac.uk/pipermail/xml-dev/1999-June/013125.html> is prior art to the subject application. Applicants' representative respectfully submits that the Examiner has not made an adequate showing that this reference is prior art to the subject application. The reference as it appears posted on the Internet on October 13, 2005 is marked with the date June 1999. However, the Examiner has not provided any evidence to verify that this reference was indeed posted on the Internet in June of 1999. Given that anyone can create a web page and put any date on the web page they care to put on it, Internet web pages as a source of prior art are suspect. Thus, without evidence to corroborate that the information on the X-Schema web page was indeed publicly available prior to the filing date of the subject application, the Examiner has not made an adequate showing that the reference is prior art to the subject patent application.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP250US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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